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Ditthavong Mori & Steiner, P.C.
918 Prince Street
Alexandria, VA 22314

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NGUYEN, THUONG

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte MATTI SALMI and FRANK DAWSON

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Appeal 2009-013374
Application 10/099,853
Technology Center 2400

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Before THOMAS S. HAHN, DENISE M. POTHIER, and
THOMAS L. GIANNETTI, *Administrative Patent Judges*.

POTHIER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-12, 14-26, 28-39, 41-53, 55-59, 61, 62, 64, 65 and 67. The Examiner objects to claims 13, 27, 40, 54, 60, 63 and 66 as being dependent upon a rejected base claim but indicates that they would be allowable if rewritten in independent form. Final Rej. 21. We have jurisdiction under 35 U.S.C. § 6(b). We affirm but designate the affirmance as new grounds.

Invention

Appellants' invention relates to a data structure for defining two-level identification within an instant messaging (IM) environment and for communicating between a terminal device and a server. *See* Abstract. Claim 1 is reproduced below:

> 1. Method for communicating a primitive from a terminal device to a network, said primitive having information elements with a structure recognized by said terminal device and at least one other entity able to communicate over said network, comprising:
> providing said primitive with an information element identifying a client of said terminal device, and
> providing said primitive also with an information element identifying a user of said client.

The Examiner relies on the following as evidence of unpatentability:

Aravamudan	US 6,301,609 B1	Oct. 9, 2001 (filed Sept. 8, 1999)
Mendiola	US 2002/0006803 A1	Jan. 17, 2002 (filed May 2, 2001 with Provisional App. No. 60/203,928, filed May 12, 2000)

Appeal 2009-013374
Application 10/099,853

THE REJECTIONS

1. Claims 1-5, 7-12, 14-19, 21-26, 28-32, 34-39, 41-46, 48-53, 55-59, 61, 62, 64, 65, and 67[1] are rejected under 35 U.S.C. § 102(e) as anticipated by Aravamudan. Ans. 3-19.[2]

2. Claims 6, 20, 33, and 47 are rejected under 35 U.S.C. § 103(a) as unpatentable over Aravamudan and Mendiola. Ans. 19-22.

THE ANTICIPATION REJECTION OVER ARAVAMUDAN

Regarding representative independent claim 1, Appellants assert that Aravamudan fails to disclose a primitive "with an information element identifying a client of said terminal device" and "also with an information element identifying a user of said client[.]" App. Br. 6-7; Reply Br. 2-3.

ISSUE

Under § 102, has the Examiner erred in rejecting claim 1 by finding that Aravamudan provides a primitive with two information elements?

ANALYSIS

We begin by construing the key disputed limitations in claim 1. Claim 1 recites, in pertinent part, "providing said primitive with an information element identifying a client of said terminal device" and "providing said primitive also with an information element identifying a user

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[1] While claim 67 is not listed in the heading of the rejection (*see* Ans. 3), the claim is addressed in the rejection's body (*see* Ans. 18-19).
[2] Throughout this opinion, we refer to (1) the Appeal Brief filed December 3, 2007; (2) the Examiner's Answer mailed February 4, 2008; and (3) the Reply Brief filed March 20, 2008.

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of said client." All claim limitations must be considered when determining patentability. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983). However, we need not give patentable weight to non-functional descriptive material absent a new and unobvious functional relationship between the descriptive material and its substrate. *In re Ngai,* 367 F.3d 1336, 1339 (Fed. Cir. 2004); *Gulack*, 703 F.2d at 1385.

As a general proposition, merely reciting what data or information represents constitutes non-functional descriptive material as it does not further limit the claimed invention either functionally or structurally. Here, the recitations to the information elements identify "a client of said terminal" and "a user of said client" and merely describe what the information elements represent. Such information elements do not limit the claimed steps either functionally or structurally. Rather, the information elements are merely being provided. Thus, the recited information elements are properly considered to contain non-functional descriptive material that do not patentably distinguish over the prior art. *See Ngai*, 367 F.3d at 1339; *see also Ex parte Nehls*, 88 USPQ2d 1883, 1887-89 (BPAI 2008) (precedential) and *Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005), *aff'd* (Fed. Cir. No. 2006-1003, June 12, 2006). As such, arguments addressing whether Aravamudan discloses information elements that identify a client or a client's user (App. Br. 6-8) and what the proper meaning of the "client" recited in claim 1 is (App. Br. 6, 8-10; Reply Br. 4-5) are not persuasive.

Also, the preamble in claim 1 recites the method is for communicating the primitive from a terminal device to a network. This communicating aspect is not limiting but rather recites the intended purpose of the method. *See Catalina Marketing Int'l, Inc., v. Coolsavings.com, Inc.*, 289 F.3d 801,

808 (Fed. Cir. 2002). We further find that the two information elements recited in the body further limit the recited "information elements" in the preamble and are not distinct information elements from those recited in the preamble. Additionally, an example of a primitive in the disclosure includes a message (Spec. 14:17) but the term, "primitive," has not been specially defined in the Specification. As such, claim 1 includes a method having two providing steps that collectively claim providing the primitive, such as a message, with two distinct information elements.[3]

Turning to Aravamudan, we agree with the Appellants that the Examiner's cited passages do not necessarily disclose the same primitive with separate information elements. *See* App. Br. 6. The Examiner cites to column 4, line sixty-five through column 5, line thirteen. Ans. 3, 22-23. This passage discusses an IM server 130 acting as a third party server that interfaces with the client through client premises equipment (CPE) 140 (e.g., a computer, phone) and the proxy presence within the Communication Services Platform (CSP). *See also* col. 3, ll. 30-37. This passage also explains that the client registers with a third party provider and with a service provider for data and communication. Yet, there is no explicit discussion of creating a message having two information elements during interfacing or registration.

The Examiner also relies on column 6, lines 45-63 in Anavamudan to disclose the recited providing a primitive step. Specifically, the Examiner states (Ans. 3-4, 23) that Aravamudan discloses both a registered address

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[3] Notably, our claim construction differs from the Examiner's. *See* Ans. 23 (stating that "[t]here is nothing in the claim indicat[ing] 'identify[ing] the user and client are provided in the same primitive and [are] separate information.'")

and user's identification. This passage comes closer to disclosing the recited primitive with two information elements. Aravamudan discusses a provisioning server that registers the address of the user's IM server and provides the client CPE software with a unique identification. *See* col. 6, ll. 50-53. But, there is inadequate evidence in Aravamudan that these pieces of information (i.e., the user address and unique identification) are within the same message or primitive.

Also, while not discussed by the Examiner, this part of Aravamudan discloses that the user connects and registers the provider's secure provisioning server by entering a password at step 206 and thus provides a message with an information element (e.g., a password). Col. 6, ll. 47-50; Fig. 4. Figure 4 further shows that step 206 includes registering both the name and password. *See* Fig. 4. While this passage may *suggest* both the name and password are part of the same message, this part does not necessarily disclose or anticipate providing a single message or primitive having these two information elements.

Yet, another portion of Aravamudan discloses the recited limitations in claim 1. Aravamudan discloses a step 234 where the client CPE software generates a message (e.g., a primitive) that indicates at least two pieces of information (e.g., user online status and current user address) and is sent to the IM server. *See* col. 7, ll. 5-13; Fig. 5. Thus, this provided message or primitive includes two information elements. Moreover, even though the recitations in the preamble do not limit claim 1, this portion of Aravamudan also teaches that this message is communicated from a terminal device (e.g., a CPE) to a network (e.g., the IM server).

Because we are relying on different portions of Aravamudan than the
Examiner in concluding that Aravamudan anticipates claim 1, we designate
this rejection as a new ground under 37 C.F.R. § 41.50(b). The new ground
designation applies similarly for claims 2-5, 7-12, 14-19, 21-26, 28-32, 34-
39, 41-46, 48-53, 55-59, 61, 62, 64, 65, and 67. Independent claims 15, 28,
42, 56, 59, 61, and 64[4] include claim language similar to the above disputed
limitations, and the above analysis equally applies to these claims. For the
dependent claims, we adopt the Examiner's findings and reasoning (*see* Ans.
4-19), which have not been challenged by Appellants.

For the foregoing reasons, Appellants have not persuaded us of error
in the rejection of independent claim 1 and claims 2-5, 7-12, 14-19, 21-26,
28-32, 34-39, 41-46, 48-53, 55-59, 61, 62, 64, 65, and 67 not separately
argued with particularity (App. Br. 10-12).

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[4] If there is further prosecution of these claims, the Examiner should
consider whether claims 28, 42, and 64 comply with 35 U.S.C. § 112, first
paragraph. *See In re Hyatt*, 708 F.2d 712, 714 (Fed. Cir. 1983); s*ee also Ex
parte Miyazaki*, 89 USPQ2d 1207, 1217 (BPAI 2008) (precedential) (noting
the "*Halliburton* case remains viable for claims having purely functional
language which is *unlimited* either by (1) the application of 35 U.S.C. § 112,
sixth paragraph, or (2) the additional recitation of structure" (emphasis in
original)). Arguably, these claims have no transitional phrase and recite
only how the device or server functions or constitute a single means claims.
The Examiner should also consider whether claims 59 and 61 comply with
35 U.S.C. § 112, second. *See Aristocrat Techs. Australia Pty Ltd. v. Int'l
Game Tech*, 521 F.3d 1328 (Fed. Cir. 2008); *see also Supp. Examination
Guidelines for Determining Compliance with 35 U.S.C. 112 and for
Treatment of Related Issues in Patent Applications*, 76 Fed. Reg. 7162,
7167-68 (Feb. 9, 2011). These claims include many mean-plus-function
limitations.

THE OBVIOUSNESS REJECTION

Claims 6, 20, 33, and 47 depend from independent claims 1, 15, 28, and 42. Appellants have not separately argued the obviousness rejection and rely on the arguments presented for their respective independent claims. *See* App. Br. 12. We are not persuaded by Appellants' arguments for the reasons disclosed above with regard to Aravamudan and representative claim 1.

As stated above, we are relying on different portions of Aravamudan than the Examiner in concluding that Aravamudan teaches a primitive with two information elements. Thus, we also designate this obviousness rejection as a new ground of rejection under 37 C.F.R. § 41.50(b). Concerning the remaining limitations in these claims, we adopt the Examiner's findings and reasoning (*see* Ans. 19-22), which have not been challenged by Appellants.

CONCLUSION

The Examiner did not err in rejecting claims 1-5, 7-12, 14-19, 21-26, 28-32, 34-39, 41-46, 48-53, 55-59, 61, 62, 64, 65, and 67 under § 102 and claims 6, 20, 33, and 47 under § 103.

DECISION

The Examiner's decision rejecting claims 1-12, 14-26, 28-39, 41-53, 55-59, 61, 62, 64, 65 and 67 is affirmed but the rejections are designated as new grounds.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that "[a] new ground of rejection . . . shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

<u>AFFIRMED</u>
<u>37 C.F.R. § 41.50(b)</u>

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